

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-13 are pending in the application.

In the Official Action, Claims 1-7 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Obuchi et al. (U.S. Patent No. 6,597,674, hereinafter Obuchi); and Claims 2-6 and 8-12 were indicated as containing allowable subject matter.

In the indication of allowable subject matter Claims 2-6 and 8-12 were indicated as being rejected under 35 U.S.C. § 112, second paragraph. Applicants submit that this is a cut and paste error from the previous Office Action. Applicants' previously filed amendment corrected deficiencies identified in the previous Office Action and thus overcame the rejections under 35 U.S.C. § 112, second paragraph.

Applicants acknowledge with appreciation the indication of allowable subject matter.

Briefly recapitulating, Claim 1 is directed to a spreading code synchronization method in a mobile communication system where, during handover of a mobile station from a first base station in communications with a second base station expected to initiate new communications, synchronous detection is carried out to detect a first spreading code assigned to the second base station. The detection is out of received signals which are received each by the mobile station and each of which includes an information data symbol spread by a combination of the first spreading code and a second spreading code. The received signals also include a mask symbol spread by only the second spreading code. The spreading code synchronization method includes a first step of detecting a received timing of a mask symbol of said second base station in a state in which a received timing of the mask symbol from the first base station is excepted from candidates of received timings for the

synchronous detection. The method includes a second step of carrying out the synchronous detection of the first spreading code assigned to the second base station.

Obuchi describes a handover method, a base station, and a mobile station for a CDMA mobile communication system, configured to improve the efficiency of inter-frequency handover. Handover is achieved between a mobile station and distributed base stations and the like. The base stations have different traffic channel frequencies. In a normal mode, a signal unit transmitted through a traffic channel consists of four frames. In a compression mode, the base station temporally compresses two normal frames into a single frame period and then transmits the frames twice through the traffic channel. The mobile station switches the reception frequency of a present traffic channel and the reception frequency of a perch channel of the destination base station at intervals of two normal-mode frames at the head of each frame received from the perch channel. The mobile station then restores frames received from the traffic channel in the compression mode to the original frames and processes them. At the same time, the mobile station extracts a system frame number from two frames received from the perch channel.¹

Obuchi further describes that the mobile station receives signals from the perch channels of peripheral base stations, despreads the signals according to the common short code, memorizes timing having a high correlative value, uses the timing to despread the signals according to all group short codes used for the second perch channels, and selects a group short code having a high correlative value. For example, a group short code involves 16 long codes, and 16 group short codes are prepared, so that 256 long codes are divided into 16 groups. Sixteen long codes belonging to the group short code having the high correlative value are used to despread the received data, and a long code having a high correlative value

¹ Obuchi, Abstract.

is found. The found long code is used to despread the received data and carry out a reception process.²

However, as acknowledged in the Official Action, Obuchi fails to disclose or suggest “detecting the received timing of a mask symbol from a second base station in which a received timing of the mask symbol from the first base station is excepted from candidates of received timings.” Nonetheless, the Official Action asserts it would be obvious to except the mask symbol from the first base station. Applicants are unclear if this finding is based on Official Notice or on a finding of inherency.

If the rejection is based on a statement of inherency, the assertion of inherency is insufficient to show that Obuchi inherently teaches the feature in question because the rejection fails to show “that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art”³ The Official Action provides no rationale for a finding of inherency. “The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.”⁴ “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not

² Obuchi column 2, lines 41-54.

³ See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,” (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (“[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,’” citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient,” Id. at 1269 (citation omitted)).

⁴ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

sufficient.”⁵ Because the Official Action provides no explanation of why Applicants’ claimed features are inherent, Applicants submit the rejection is improper.⁶

If the rejection is based on Official Notice, as noted in the Official Action, Obuchi does not disclose or suggest the feature in question. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art.⁷ However, as set forth in M.P.E.P. § 2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion. Applicants respectfully traverse the present rejection if said rejection relies on Official Notice. Applicants do not consider the features for which Official Notice were taken to be “of such notorious character that official notice can be taken.”

Because rejections based on inherency or Official Notice are improper, Applicants turn to MPEP §706.02(j) which notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because Obuchi fails to disclose all the features of Applicants’ claimed invention.

⁵ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁶ MPEP § 2112, IV “Examiner must provide rationale or evidence tending to show inherency.”

⁷ *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)

Applicants amend Claim 2 by incorporating all the features of Claim 1, and also amends Claims 3 and 5 so as to directly depend on the new independent Claim 2. Hence, by the Office Action indication on allowable subject matter, Claims 2, 3, and 5 are now allowable.

Applicants also amend Claim 8 by incorporating all the features of Claim 7, and also amends Claims 9, 11, and 13 so as to directly depend on the new independent Claim 8. Hence, by the Office Action indication on allowable subject matter, Claims 8, 9, 11, and 13 are now allowable.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request and early and favorable action to that effect.

Respectfully submitted,

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